

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	:	EXPEDITED PROCEDURE
	:	:	Response under 37 CFR 1.116
Yasuhiko KENMOCHI et al.	:	:	Confirmation No. 6485
	:	:	
Serial No. 10/753,531	:	:	Group Art Unit: 3761
	:	:	
Filed: January 9, 2004	:	:	Examiner: Michele M. Kidwell
	:	:	

For: PULL-ON DISPOSABLE WEARING ARTICLE WITH TAPERED FOLDING GUIDE
LINES AND TUCKING ZONES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
COMMISSIONER FOR PATENTS
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Sir:

This paper is submitted in reply to the Final Office Action mailed *August 21, 2008*.

Applicants respectfully request review of the final rejections as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the final rejections.

1. As to independent claim 1, the final rejection is traversed for at least the reasons presented in the August 4, 2006 Amendment, at page 10, lines 3-19, and the May 19, 2008

Response to Notice of Non-responsiveness, at page 3, the second full paragraph. The previous traversing arguments are incorporated by reference herein.

The Office responded, at page 3, lines 9-10 from bottom, to the May 19, 2008 argument, i.e., “first and second leg elastics 31 are considered to be located inboard opposite sides of [the] core.” Applicants respectfully disagree, because FIG. 6 of *Otsubo* ‘851 clearly discloses the opposite, i.e., leg elastics are located outboard of the opposite sides of the core 24.

If it is the Office’s opinion that the first and second leg elastics 31 are considered to be located inboard of the opposite sides of the core when the diaper is folded as shown in FIGs. 7-9 of *Otsubo* ‘851, then Applicants respectfully submit that the final rejection as formulated has failed to properly established *prima facie* case of anticipation. In particular, the reference as applied in the Final Office Action does not *explicitly* teach or disclose anywhere that the leg elastics 31 are located inboard as presently claimed. The Final Office Action has also failed to prove that the claim feature is *inherent* in the prior art teaching, providing no “basis in fact and/or technical reasoning to reasonably support the determination that the [claim feature] necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added).

Accordingly, Applicants respectfully submit that the anticipatory rejection of claim 1 is clearly erroneous and should be withdrawn. The final rejections of the claims depending on claim 1 are also erroneous and should be withdrawn for at least the same reasons.

2. As to claim 4, the reference as applied in the Final Office Action does not teach or disclose that “a stiffness of said core in said first and second zones and outside said folding guide lines is lower than in said third zone.”

The Office’s reliance on welding zone 16 of *Otsubo* ‘851 for the claim feature is noted. The welding zone is, however, not part of the core 14 (*see* also Final Office Action at page 3, line 8); it

is part of the outer layer(s) of the *Otsubo* '851 garment. Welding zone 16 might be related to the stiffness of the whole garment, but it is not evidence that the core 14 of *Otsubo* '851 has different stiffnesses in the first/second and third zones.

Accordingly, Applicants respectfully submit that the anticipatory rejection of claim 4 is clearly erroneous and should be withdrawn.

3. As to claim 7, the reference as applied in the Final Office Action does not teach or disclose “two longitudinal barriers disposed on opposite sides of said core to prevent lateral leakage of bodily discharge, wherein said first and second elastically stretchable and contractible members are disposed between and inwardly spaced from entireties of said longitudinal barriers.”

The Office's reliance on waist elastics 30 of *Otsubo* '851 for the claimed barriers is not understood. See Final Office Action at page 3, line 8 from bottom. A person of ordinary skill in the art would understand that waist elastics 30 are not barriers, especially, not ones that prevent *lateral* leakage of bodily discharge as defined in claim 7.

If it is the Office's position that such barriers are inherent in the structure of *Otsubo* '851, then Applicants respectfully traverse because a *prima facie* case of inherency has not been properly established. In addition, a person of ordinary skill in the art would understand that any barrier that might be present in *Otsubo* '851 would be positioned between core 14 and the associated leg opening. In other words, any barriers that *Otsubo* '851 might have would be positioned between the first and second elastics 31. The claim language calls for the opposite arrangement, i.e., the first and second elastic members are disposed between the barriers.

Accordingly, Applicants respectfully submit that the anticipatory rejection of claim 7 is clearly erroneous and should be withdrawn.

4. As to claims 8-9, the reference as applied in the Final Office Action does not teach

or disclose that “said first and second elastically stretchable and contractible members are disposed below said core, between said core and an impervious cover sheet covering a lower surface of said core” as recited in claim 9, and that “each of said first and second elastically stretchable and contractible members is directly attached to said core” as recited in claim 8.

The Office alleges that *Otsubo* ‘851 teaches at column 4 lines 35-40 that the elastics are directly bonded to the core and thus disposed between the core and the backsheet. Applicants respectfully disagree because the cited portion of *Otsubo* ‘851 does not teach such. There is no teaching either explicit or implicit in *Otsubo* ‘851 as to any direct elastic-core attachment. The reference as applied in the Final Office Action does not anticipate claim 8.

The cited portion of *Otsubo* ‘851 also discloses that the elastics are disposed between the topsheet and backsheet, and so is the core. See *Otsubo* ‘851 at column 4 lines 15-17. Thus, the elastics appear to be coelevational with, rather than below, the core. Therefore, the reference as applied in the Final Office Action does not anticipate claim 9.

The Office’s response to the above arguments in the Final Office Action at page 5, the second full paragraph is noted. Applicants respectfully disagree, because the *Otsubo* ‘851 portions cited in the Final Office Action, at best, only establishes that the core is indirectly attached to the elastics via either topsheet or backsheet. There is no basis to conclude that the core is *necessarily* directly attached to the elastics. To the contrary, FIG. 6 of *Otsubo* ‘851 clearly shows that such direct attachment is impossible as elastics 31, 30 are all located outside the boundary of core 14.

Accordingly, Applicants respectfully submit that the anticipatory rejection of claims 8-9 is clearly erroneous and should be withdrawn.

5. As to claim 24, the final rejection is clearly erroneous for the reason detailed with respect to claim 8 from which claim 24 depends. The rejection of claim 24 is also erroneous because *Otsubo* ‘851 as applied in the Final Office Action does not teach or disclose the claim

feature that "said first and second elastically stretchable and contractible members are disposed between said back sheet and said core" as discussed above with respect to claim 9.

6. As to independent claim 27, note at least the discussion *supra* with respect to claim 1. The anticipatory rejections of claim 27 and the claims depending thereon are clearly erroneous and should be withdrawn.

7. As to new claim 28, note at least the discussion *supra* with respect to claim 4.

8. As to new claims 30 and 32, note at least the discussion *supra* with respect to claim 8.

9. As to new claim 31, note at least the discussion *supra* with respect to claim 9.

Withdrawal of the final rejections in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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